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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,447	12/27/2001	Brian Moran	005258.P004	9325

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EXAMINER

EWART, JAMES D

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,447

Applicant(s)

MORAN ET AL.

Examiner

James D Ewart

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 7 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6 are, drawn to rerouting a wireless message to locate a destination device service provider, classified in Class 455, subclass 466.

II. Claim 7 is, drawn to a method for rerouting a message sent from a roaming device while roaming, classified in Class 455, subclass 432.1.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions [I] and [II] are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the first group relates to locating a destination device service provider and the the second group relates to sending a message while roaming. The first group includes a phone number and ping message and the second group includes redirecting a message from the SMSC home carrier of the sender.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

5. A telephone call was made on July 6, 2004 to Mr. Alan Burnett who elected without traverse group 1 to be examined.

Drawings

6. The specification discusses labels 10, 12 and 18 in figure 1 (see 0006), but these labels are not provided in figures 1.

Claim Objections

7. Claim 4 states “map table *the* maps” and should be “map table *that* maps”. Claim 4 also states “to any service providers” and should be to any service provider”.

8. Claim 5 states “back to the sending device if not service provider successfully responds to any of” should probably be “back to the sending device if a service provider *does not* successfully responds to any of”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 indicates pinging potential service providers, but claim 3 indicates determining the service provider therefore the pinging of claim one is not required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calatrava-Requena et al. (U.S. Patent No. 6,748,229) in view of Agarwal et al. (U.S. Patent No. 6,138,023) and further in view of Roundtree (U.S. Patent No. 6,640,098)

Referring to claim 1, Calatrava-Requena et al. teaches a method for rerouting a wireless message to locate a destination device service provider (Column 9, Lines 28-35), comprising: requesting to send a wireless message from a sending device (Column 10, Lines 11-14) that uses a first service provider (Column 8, Line 66 to Column 9, Line 6) to a destination device that uses a second service provider (Column 8, Line 66 to Column 9, Line 6), referencing a phone number for the destination device (Column 10, Lines 30-34 and Column 12, Lines 59-60) and sending the message to the destination device (Column 14, Lines 8-10), but does not teach identifying potential service providers for the destination device based on the phone number. Agarwal et al. teaches identifying potential service providers for the destination device based on the phone number (Column 4, Line 64 to Column 5, Line 13). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Calatrava-Requena et al. with the teaching of Agarwal et al. of identifying potential service providers for the destination device based on the phone number to provide appropriate routing

(Column 5, Lines 8-13). Calatrava-Requena et al. and Agarwal et al. teach the limitations of claim 1, but do not teach sending a ping message, receiving a ping message and responding to a ping message that is received. Roundtree teaches sending a ping message, receiving a ping message and responding to a ping message that is received (Figure 6). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Calatrava-Requena et al. and Agarwal et al. with the teaching of Roundtree of sending a ping message, receiving a ping message and responding to a ping message that is received to obtain needed information (Column 2, Line 47).

Referring to claim 2, Calatrava-Requena et al. further teaches reformatting the message from a first message format used by the first service provider to a second message format used by the second service provider (Column 2, Lines 57-59; Column 9, Lines 9-11 and Figure 7; S705,S706).

Referring to claim 3, Agarwal et al further teaches looking up a target service provider in a database mapping wireless device phone numbers to wireless device providers; and sending via a service provider that is mapped to the phone number of the destination device (Column 3, Lines 47-53).

Referring to claim 4, Agarwal et al further teaches maintaining a phone map table the maps wireless device phone numbers to corresponding service providers; and updating the phone map table to map the destination device phone number and service provider (Column 5,

Lines 18-19), but neither Calatrava-Requena et al. or Agarwal et al. teaches sending a ping message and responding to a received ping message. Roundtree teaches sending a ping message and responding to a received ping message (Figure 6). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Calatrava-Requena et al. and Agarwal et al. with the teaching of Roundtree of sending a ping message and responding to a received ping message to obtain needed information (Column 2, Line 47)

Referring to claim 5, Calatrava-Requena et al. further teaches sending a failure message back to the sending device and Roundtree teaches whether there is a response or not to any of the ping messages.

Referring to claim 6, Calatrava-Requena et al. further teaches recording a transaction corresponding to a successfully sent message, but does not teach identifying the service providers used in rerouting the message. Agarwal et al. teaches identifying the service providers used in rerouting the message (Column 4, Line 64 to Column 5, Line 13). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Calatrava-Requena et al. with the teaching of Agarwal et al. of identifying the service providers used in rerouting the message to provide appropriate routing (Column 5, Lines 8-13).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Culli et al. U.S. Patent No. 6,618,472 discloses local routing system and method.

Lumme et al. U.S. Patent No. 6,587,693 discloses e-mail traffic in a mobile communications system.

Martin et al. U.S. Patent No. 6,298,232 discloses voice mail service notification between mobile systems.

Ross et al. U.S. Patent No. 6,263,212 discloses short message service center.

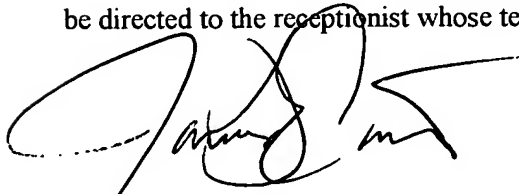
Sawyer et al. U.S. Patent No. 5,946,629 discloses cellular telephone network having short message service interaction with other networks.

Wicki et al. U.S. Patent No. 5,740,346 discloses system and method for dynamic network topology exploration.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James D Ewart whose telephone number is (703) 305-4826. The examiner can normally be reached on M-F 7am - 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703)308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.



Ewart July 6, 2004



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
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